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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/712,916	11/13/2003	Hisaki Miyamoto	YAMAP0398USD	2362

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EXAMINER

HARAN, JOHN T

ART UNIT PAPER NUMBER

1733

DATE MAILED: 10/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/712,916

Applicant(s)

MIYAMOTO ET AL.

Examiner

John T. Haran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11/13/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Information Disclosure Statement

1. The information disclosure statement (IDS) submitted on 11/13/03 has been considered by the examiner.

Reissue Applications

2. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.
3. The reissue oath/declaration filed with this application is defective because the error which is relied upon to support the reissue application is not an error upon which a reissue can be based. See 37 CFR 1.175(a)(1) and MPEP § 1414.

Claims 10-16 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is that stating the error is "a failure to include the claims in the original patent" is not considered an acceptable statement of error. If new claims are presented their differences from the original claims must be pointed out. See MPEP 1414.

Double Patenting

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 10-13 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 12, 18, and 19 of U.S.

Patent No. 5,681,634 in view of Anezaki (U.S. Patent 5,202,171).

Regarding claim 10, claim 6 of the patent encompasses claim 10 of the present application. Claim 10 of the present application is narrower in that it requires the stopper to prevent the resin from flowing past the stopper, whereas claim 6 of the patent just requires that the stopper prevent resin from flowing into the central hole but reads on some resin still flowing past the stopper. It is well known and conventional in the art to have a stopper close to the inner circumference of an optical disc that prevents any resin from spreading past it during assembly as shown for example by Anezaki et al (Column 6, lines 40-54). There is sufficient motivation to have designed the amount of resin and depth and shape of the stopper to have a disc where the stopper prevents the resin from flowing past the stopper as such is conventional in the optical disc art. It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an optical disc wherein the stopper prevents resin from flowing past the stopper in combination with the other teachings of U.S. Patent 5,681,634, as suggested in Anezaki.

Regarding claim 11, claims 6 and 12 of the patent encompasses claim 11 of the present application. The stopper of claim 6 encompasses a ring-shaped groove. Claim 11 of the present application is narrower in that it requires the stopper to prevent the resin from flowing past the stopper, whereas claim 6 of the patent just requires that the stopper prevent resin from flowing into the central hole but reads on some resin still flowing past the stopper. It is well known and conventional in the art to have a stopper close to the inner circumference of an optical disc that prevents any resin from spreading past it during assembly as shown for example by Anezaki et al (Column 6, lines 40-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an optical disc wherein the stopper prevents resin from flowing past the stopper in combination with the other teachings of U.S. Patent 5,681,634, as suggested in Anezaki.

Regarding claim 12, claims 18 and 19 of the patent encompasses claim 12 of the present application. Claim 12 of the present application is narrower in that it requires the stopper to prevent the resin from flowing past the stopper, whereas claim 18 of the patent just requires that the stopper prevent resin from flowing into the central hole but reads on some resin still flowing past the stopper. It is well known and conventional in the art to have a stopper close to the inner circumference of an optical disc that prevents any resin from spreading past it during assembly as shown for example by Anezaki et al (Column 6, lines 40-54). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have an optical disc wherein the

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stopper prevents resin from flowing past the stopper in the method of U.S. Patent 5,681,634, as suggested in Anezaki.

Regarding claim 13, the stopper of claim 18 of the patent encompasses a ring-shaped groove and it would have been obvious to use a ring-shaped groove for the stopper because the patent teaches such.

It is noted that the present application claims priority to U.S. Patent 5,681,634, however the obviousness double patenting rejection is proper because if the claims had been originally presented they would not have been restricted.

6. Claims 14-16 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 6, 12, 18, and 19 of U.S. Patent No. 5,681,634 in view of Sugaya et al (U.S. Patent 5,459,712).

Regarding claim 14, claim 6 of the patent encompasses claim 10 of the present application. Claim 14 of the present application is narrower in that it requires the substrates to have a thickness of 0.6mm, whereas claim 6 of the patent has no thickness requirement. It is well known and conventional in the art to for the substrates of an optical disc to be 0.6mm, as shown for example in Sugaya et al (Column 9, lines 5-10). It would have been obvious to one of ordinary skill in the art to have used substrates of conventional thickness in the optical disc of U.S. Patent 5,681,634.

Regarding claim 15, claim 12 of the patent encompasses claim 10 of the present application. Claim 15 of the present application is narrower in that it requires the substrates to have a thickness of 0.6mm, whereas claim 12 of the patent has no

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thickness requirement. It is well known and conventional in the art to for the substrates of an optical disc to be 0.6mm, as shown for example in Sugaya et al (Column 9, lines 5-10). It would have been obvious to one of ordinary skill in the art to have used substrates of conventional thickness in the optical disc of U.S. Patent 5,681,634.

Regarding claim 16, claim 18 of the patent encompasses claim 10 of the present application. Claim 16 of the present application is narrower in that it requires the substrates to have a thickness of 0.6mm, whereas claim 18 of the patent has no thickness requirement. It is well known and conventional in the art to for the substrates of an optical disc to be 0.6mm, as shown for example in Sugaya et al (Column 9, lines 5-10). It would have been obvious to one of ordinary skill in the art to have used substrates of conventional thickness in the method of U.S. Patent 5,681,634.

It is noted that the present application claims priority to U.S. Patent 5,681,634, however the obviousness double patenting rejection is proper because if the claims had been originally presented they would not have been restricted.

Conclusion

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to **John T. Haran** whose telephone number is **(571) 272-1217**. The examiner can normally be reached on M-Th (8 - 5) and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Blaine Copenheaver can be reached on (571) 272-1156. The fax phone

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number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John T. Haran
Examiner
Art Unit 1733